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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/647,005	09/26/2000	David Darras	Q60875	3841

7590

07/09/2003

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EXAMINER

MIGGINS, MICHAEL C

ART UNIT

PAPER NUMBER

1772

12

DATE MAILED: 07/09/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/647,005

Applicant(s)

DARRAS ET AL.

Examiner

Michael C. Miggins

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1772

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 18 June 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 11 June 2003. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☒ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

3. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attachment.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: none.Claim(s) objected to: none.Claim(s) rejected: 1-8 and 25-28.Claim(s) withdrawn from consideration: none.

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☒ Other: see attachment

Continuation of 3. Applicant's reply has overcome the following rejection(s): All of the 35 USC 112 rejections previously of record have been withdrawn.

### **ANSWERS TO APPLICANT'S ARGUMENTS**

Applicant's arguments filed 6/11/03 with regards to the 35 USC 112 rejections of record are persuasive and all of the 35 USC 112 rejections previously of record in paper #8 have been withdrawn.

Applicant's arguments filed 6/11/03 with regards to the 35 USC 103(a) rejections of record in paper #8 have been fully considered but are deemed unpersuasive. Applicant has argued that the motivation to combine must be found in the prior art and cannot be based on applicant's disclosure and that Danzer is completely silent about using its carbon to coat a substrate of polymer material. However, Nagashima discloses a barrier amorphous hard carbon layer disposed on a polymer layer (column 3, line 36 through column 4, line 15). The only thing missing from the Nagashima reference with regard to the independent claim 1 is the limitation with regard to the amorphous carbon having a polymer tendency. Danzer disclose an amorphous carbon having polymer tendency (see introduction, page 119 in it's entirety) for the purpose of providing improved mechanical properties, for example Danzer describes the layer as being soft as opposed to hard which clearly suggests a more flexible film as opposed to a hard diamond film like the one used in Nagashima. Therefore one of ordinary skill in the art would have been motivated to use the amorphous carbon having polymer tendency in the container of Nagashima to improve mechanical properties such as flexibility. Further it is within the purview of one of ordinary skill in the art to select an amorphous carbon layer from the prior art which has improved mechanical properties. Thus one of ordinary skill in the art does not need applicant's disclosure to combine the

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references especially since the amorphous carbon layer of Danzer has improved mechanical properties, i.e. flexibility.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Applicant has argued that Danzer discloses the use of carbon as an immediate layer and not an intermediate layer, which may be true, however, Danzer does disclose depositing the amorphous carbon layer on a substrate such as aluminum (see abstract). Nagashima discloses a barrier amorphous hard carbon layer disposed on a polymer layer (column 3, line 36 through column 4, line 15) as discussed above. Applicant has argued that Danzer does not disclose the presence of  $\text{CH}^2$  or  $\text{CH}^3$  bonds in the amorphous carbon layer. However, Danzer does teach the presence of  $\text{CH}^2$  or  $\text{CH}^3$  bonds in the amorphous carbon layer (see table 6 on page 125), thus further proving that the amorphous carbon layer of Danzer is substantially similar to or the same as applicant's amorphous carbon layer and thus has the same or substantially similar properties as applicant's amorphous carbon layer. Moreover, applicant has not specified, in the claims, the presence or absence of  $\text{CH}^2$  or  $\text{CH}^3$  bonds. In response to

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applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., CH<sup>2</sup> or CH<sup>3</sup> bonds) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant has argued that the method by which applicant's amorphous carbon layer and the method by which the amorphous carbon layer of Danzer is different. However, it has been held that where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a *prima facie* case of either anticipation or obviousness has been established. *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977).

Applicant has argued that the instant invention contains unexpected results. However, applicant provides no comparative data in the specification comparing applicant's invention to the closest prior art. Applicant has also provided no comparative data comparing applicant's invention to the closest cited prior art of record which is the Danzer reference.

Applicant has argued that there would have been no reason to expect that the amorphous carbon layer of Danzer would provide barrier properties in so far as it would have been expected for the barrier properties to be provided by the aluminum itself. However, the motivation for combining the two references has nothing to do with improved barrier properties but is based on providing improved mechanical properties,

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i.e. flexibility, as discussed above. However, it is believed that the amorphous layer of Danzer has barrier properties since it is the same or substantially similar to applicant's amorphous carbon layer.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael C. Miggins whose telephone number is (703) 305-0915. The examiner can normally be reached on Monday-Friday; 1:30-10:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Pyon Harold can be reached on (703) 308-4251. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

MCM *dk*  
July 7, 2003



**WILLIAM P. WATKINS III  
PRIMARY EXAMINER**